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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,717	10/22/2001	Geoffrey B. Rhoads	P0476	4166

23735 7590 08/10/2004

DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 250
TUALATIN, OR 97062

EXAMINER

JOHNS, ANDREW W

ART UNIT PAPER NUMBER

2621

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,717

Applicant(s)

RHOADS

Examiner

Andrew W. Johns

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
 - I. Claims 1-14, drawn to encoding original data with watermark data by exploiting
5 innate biases in the original data, classified in class 382, subclass 100.
 - II. Claims 15-51, drawn to determining a segmentation of an image to insert a set of
watermarking signals to minimize the probability of detection errors, classified in
class 382, subclass 173.
2. The inventions are distinct, each from the other because of the following reasons:
10 Inventions I and II are related as subcombinations disclosed as usable together in a single
combination. The subcombinations are distinct from each other if they are shown to be
separately usable. In the instant case, invention I has separate utility such as encoding data
without selecting segments that minimize the probability of detection errors. See M.P.E.P. §
806.05(d).
- 15 3. Because these inventions are distinct for the reasons given above and the search required
for Group I is not required for Group II, restriction for examination purposes as indicated is
proper.
4. Applicant is advised that the reply to this requirement to be complete must include an
election of the invention to be examined even though the requirement be traversed (37 C.F.R. §
20 1.143).

Notice to Applicant

1. The papers filed on 19 June 2002 (certificate of mailing dated 11 June 2002) have not
25 been made part of the permanent records of the United States Patent and Trademark Office
(Office) for this application (37 C.F.R. § 1.52(a)) because of damage from the United States

Postal Service irradiation process. The above-identified papers, however, were not so damaged as to preclude the USPTO from making a legible copy of such papers. Therefore, the Office has made a copy of these papers, substituted them for the originals in the file, and stamped that copy:

5
COPY OF PAPERS
ORIGINALLY FILED

10 If applicant wants to review the accuracy of the Office's copy of such papers, applicant
may either inspect the application (37 C.F.R. § 1.14(d)) or may request a copy of the Office's
records of such papers (*i.e.*, a copy of the copy made by the Office) from the Office of Public
15 Records for the fee specified in 37 C.F.R. § 1.19(b)(4). Please do **not** call the Technology
Center's Customer Service Center to inquiry about the completeness or accuracy of Office's copy
of the above-identified papers, as the Technology Center's Customer Service Center will **not** be
able to provide this service.

20 If applicant does not consider the Office's copy of such papers to be accurate, applicant
must provide a copy of the above-identified papers (except for any U.S. or foreign patent
documents submitted with the above-identified papers) with a statement that such copy is a
complete and accurate copy of the originally submitted documents. If applicant provides such a
copy of the above-identified papers and statement within **THREE MONTHS** of the mail date of
this Office action, the Office will add the original mailroom date and use the copy provided by
25 applicant as the permanent Office record of the above-identified papers in place of the copy
made by the Office. Otherwise, the Office's copy will be used as the permanent Office record of
the above-identified papers (*i.e.*, the Office will use the copy of the above-identified papers made
by the Office for examination and all other purposes). This three-month period is not
extendable.

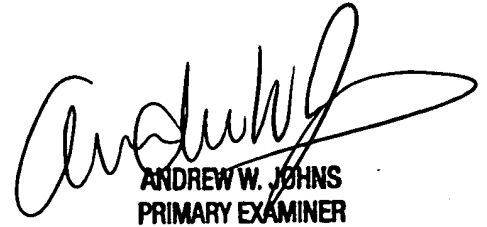
30 5. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Andrew Johns whose telephone number is (703) 305-4788. The
examiner is normally available Monday through Friday, at least during the hours of 9:00 am to
3:00 pm Eastern Time. The examiner may also be contacted by e-mail using the address:
35 andrew.johns@uspto.gov. (Applicant is reminded of the Office policy regarding e-mail
communications. See M.P.E.P. § 502.03)

40 If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leo
Boudreau, can be reached on (703) 305-4706. The fax phone number for this art unit is (703)
872-9306. In order to ensure prompt delivery to the examiner, all unofficial communications
should be clearly labeled as "Draft" or "Unofficial."

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center Receptionist whose telephone number is (703) 305-4700.

5

A. Johns
5 August 2004



ANDREW W. JOHNS
PRIMARY EXAMINER